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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,221	07/08/2003	Ken Kutaragi	450128-04021.1	8672
20999	7590	09/16/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			FOSTER, JIMMY G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,221

Applicant(s)

KUTARAGI ET AL.

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 includes limitations which indefinitely doubly recites subject matter already introduced in claim 1.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over published Japanese Laid-open Publication No. H05-213387 in view of U.S. patent No 6,276,524 to Cerda-Vilaplana et al and published Japanese Utility Model Publication No. H04-32993. The Japanese document H05-213387, with respect to Figure 4, apparently shows/discloses using a book or notebook for holding different shaped media elements A and B, such as for holding a CD or DVD A (examiner's notation), which is circular in shape, and for holding an optical disc cartridge B (examiner's notation) which is rectangular in shape. Moreover the Japanese document No. H05-213387 discloses holding both of the media elements on the same notebook member 1 (examiner's notation) on one side of the hinge member 3. Notebook member 1 may be considered to define a

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first member; notebook member 2 (examiner's notation) may be considered to define a second member; and notebook member 3 (examiner's notation), which acts as a hinge between members 1 and 2, may be considered to define a connecting member.

The media elements A and B are capable of being used in an appropriately configured gaming apparatus and of receiving data therefrom. Moreover, the holders for the circular and rectangular shaped medias are inherently respectively capable of holding a circular recording media of appropriate size having a game software and holding a rectangular recording device of appropriate size which will be mounted in a game system. This capability meets the intended use limitations set forth in the claims.

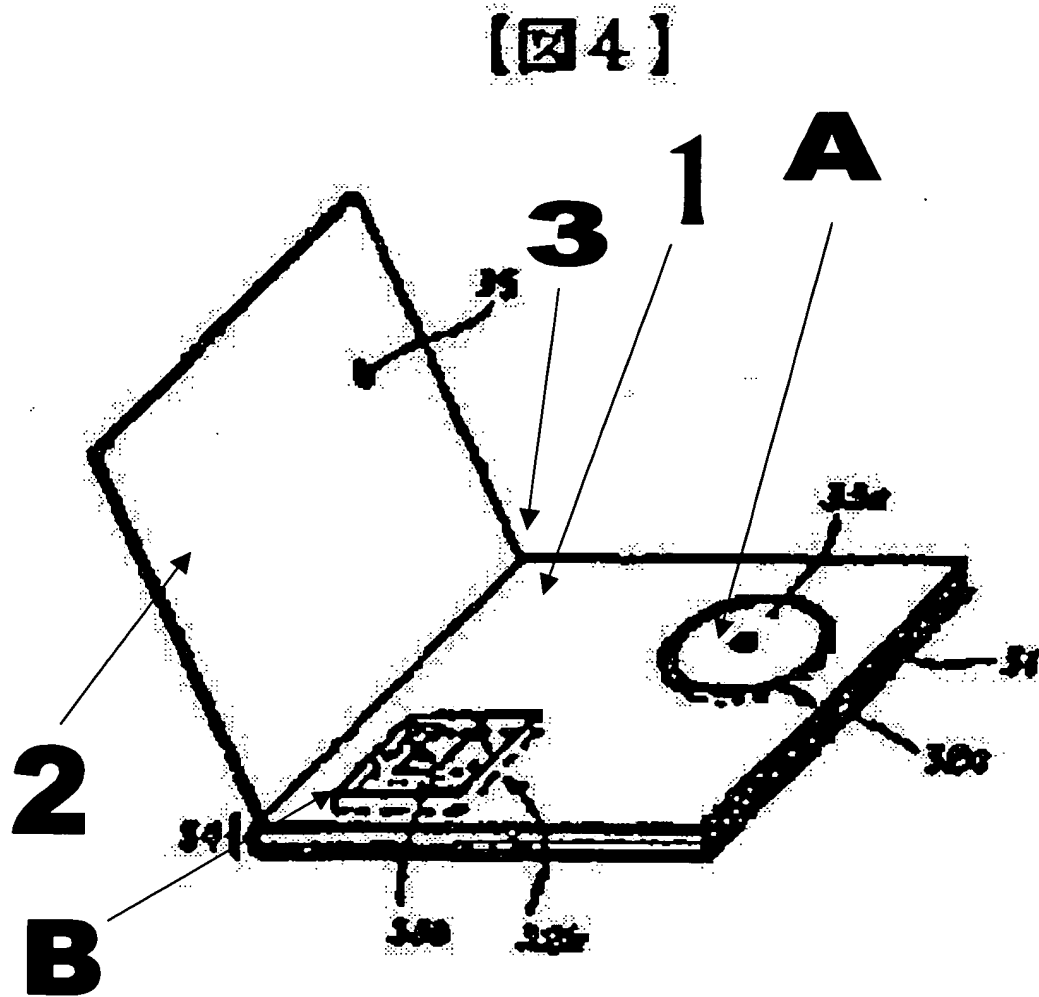
Although the Japanese document H05-213387 does not appear to disclose the holder for the rectangular media element B as defining a frame portion extending upwardly from the base of the first member 1, the Japanese document No. H04-32993 suggests that the holder for a rectangular media element/recording device, such as a memory card (3), may be formed by four L-shaped protruding portions (2), for retaining the rectangular media at the corners thereof, for the purpose of retaining the rectangular media suspended above the flat surface of the member (1). The holding structure causes storage of the media spaced above the base of the member (1) (see Fig. 2), which will permit easy grasping for removal of the rectangular media. Accordingly, it would have been obvious in view of Japanese document No. H04-32993 to have made the rectangular media holder at B (examiner's notation) of Figure 4 of Japanese document H05-213387 with L-shaped protruding portions which extend from the base of the first member 1, for the purpose of holding a rectangular media/such as a recording device memory card, above the flat surface of the base so as to permit the media to be grasped to be removed.

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With the spaced L-shaped protrusions, portions of parallel side surfaces of the rectangular media/recording device will not be engaged. This will permit the sides to be grasped for removing the media from the holder.

Although the Japanese document H05-213387 does not appear to disclose the holder for the circular media element A as being formed by an arcuate frame portion raised from the base of the first element 1, the reference of Cerda-Vilaplana et al, at projections 1d and disclosure thereof, suggests that the holder for a circular media element, such as a compact disc (CD), may include six spaced arcuate frame portions (1d) raised from the base (1b) of a case member, for the purpose of supporting the outer edge of the media above the flat surface of the case member. This would inherently hold the underside of the media from coming into contact with the flat surface. Moreover, as apparent from the reference, the frame portions (1d) would function along with a retainer of a cylindrical platform (2) to retain the media in the case but permit easy release of the media when desired.

It has been held that mere duplication of the essential working parts of a device to duplicate function of the structure involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Accordingly, to have provided more than one holding portion, each including L-shaped protrusions, for holding plural rectangular recording devices would further have been obvious as constituting a mere duplication of structure and function of what is taught by Japanese document No. H04-32993.

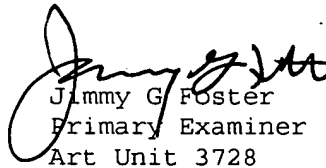


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1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
14 September 2004